

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM P. STEARNS
and NOZAR HASSANZADEH

Appeal 2007-0698
Application 09/678,318
Technology Center 2800

Decided: May 11, 2007

Before EDWARD C. KIMLIN, CHARLES F. WARREN, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

KIMLIN, *Administrative Patent Judge*.

REMAND UNDER 37 C.F.R. § 41.50(a)(1) and
ORDER UNDER 37 C.F.R. § 41.50(d)

This is the second remand of this application. Unfortunately, the present case is still not ready for a decision. As stated in our previous remand, the central issue on appeal is rather Ohsawa describes, within the meaning of § 102, the claim requirement that “each trace of each of said pair of traces being spaced from the other trace of said pair by up to a ball pitch,

being maximized for identity in length and having up to one ball pitch difference in length and being maximized for parallelism and spacing.”

The Examiner, at pages 9 and 10 of the Answer, attempts to demonstrate how Ohsawa describes the claim recitation by reproducing Figure 3J of the reference with commentary superimposed over the Figure. However, the Examiner’s comments are not readily understood. For instance, Comment (1) states that the Arrow Y indicates a ball pitch, yet no arrow is evident in the reproduced Figure. Comment (3) refers to a Length (2) that is not clear in the Figure. Comment (4) explains that Arrow X points to a pair of traces but no such arrow appears in the drawing. Also, the Examiner should explain the meaning of L1+L2 referred to in Comment (4).

Appellants, on the other hand, offer little more than conclusory remarks to the effect that the Ohsawa reference does not literally disclose the wording of the claim recitation. We agree with the Examiner that “Appellant has not pointed out specifically how Ohsawa does not read on claimed subject matter” (Answer 7, first para.). In our view, the Examiner’s rejection is based on the rationale that Ohsawa reasonably appears to disclose a pair of traces whose spacing is not greater than the ball pitch, and whose length is maximized for identity to the extent that any difference in length between the traces is not greater than one ball pitch. Also, it seems to be the Examiner’s position that the traces of Ohsawa appear to be parallel and, therefore, maximized for parallelism. Appellants, however, have simply noted in their Reply Brief that the Examiner has made no specific reference to a disclosure in Ohsawa with corresponds to the Examiner’s description of the reference. Appellants have advanced no reasoning, based on the drawings of Ohsawa, why the Examiner’s analysis is necessarily in

error, nor have Appellants set forth their own analysis of the reference disclosure

Accordingly, we hereby order Appellants to place of record a factual analysis of Ohsawa which explains why the traces of the reference are spaced from each other by greater than a ball pitch.¹ Also, Appellants should place of record definitions for the recitations “maximized for identity in length” and “maximized for parallelism and spacing.” It would seem that one of ordinary skill in the art, such as Ohsawa, would necessarily maximize the identity in length of the traces, as well as their parallelism and spacing. Indeed, based on Appellants’ Specification, it would appear that maximizing the identity in length of the traces would amount to making the pair of traces as short as possible to minimize resistance. Consequently, Appellants should establish how one of ordinary skill in the art would reasonably interpret the Ohsawa disclosure and how methods of laying out traces within the scope of the appealed claims patentably distinguish over methods fairly described by Oshawa. Manifestly, before decision on this appeal, Appellants’ position regarding any distinction between the traces presently claimed and described by Ohsawa should be clear on the record.

This remand to the Examiner pursuant to 37 C.F.R § 41.50(a)(1) is made for further consideration of a rejection. After receipt of Appellants’ response in compliance with 37 C.F.R § 41.50(d), the Examiner must acknowledge receipt and entry of the response. In addition, the Examiner may withdraw the final rejection and reopen prosecution or may furnish a

¹ Pursuant to 37 C.F.R. § 41.50(d)(1) (2004), we order the Appellants to file a Supplemental Paper to additionally brief any matter deemed appropriate for a reasoned decision on this appeal.

Supplemental Examiner's Answer responding to any new issue raised in the response. Accordingly, 37 C.F.R. § 41.50(a)(2) applies if a Supplemental Examiner's Answer is written in response to this Remand by the Board. Also, any Supplemental Answer should only be issued **after** Appellants have complied with our Order.

Appellants are given **a non-extendable time period of two (2) months** from the mailing date of this order to file a Supplemental Paper. Failure to respond within the given time period will result in the dismissal of the appeal.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

REMANDED and ORDER UNDER 37 C.F.R. § 41.50(d)(1)

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